

U.S. Patent Application No. 10/039,566

Attorney Docket No. 9777000.0022

REMARKS

Claims 1-89 are presently pending in the application. Claims 79-89 have been added.

Reconsideration and allowance of all claims are respectfully requested in view of the following remarks.

As a preliminary matter, the Applicant thanks the Examiner for the courtesies extended during the personal interview of April 2, 2003. Although no agreement was reached, the Applicant thanks the Examiner for the opportunity to more clearly define the invention with respect to prior art materials.

The Examiner has provisionally rejected Claims 1-78 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-93 of copending Application No. 10/037,188.

Copending Application No. 10/037,188 has been expressly abandoned by the Applicant concurrently herewith, and thus, the double patenting application is now moot.

The Examiner has objected to the drawings under 37 CFR 1.83(a), stating that the grommet is now shown. The Examiner is respectfully requested to acknowledge receipt of one (1) sheet of Corrected Formal Drawings, which amends Fig. 7 to show a grommet. The specification has been amended at page 11, to remove the reference to the fact that the grommet is not shown.

The Examiner has objected to the disclosure due to informalities. The disclosure has been amended to correct for the typographical error noted by the Examiner.

The Examiner has objected to Claim 3 due to informalities. Claim 3 has been amended to correct for a grammatical error, and thus, the Examiner's objection should be withdrawn.

Further, the claims have been amended to correct for matters of form. The Applicant respectfully submits that the amendments are not narrowing amendments, or related to patentability, as defined by the Supreme Court in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al., 122 S.Ct. 1831, 1838 (2002). Rather, the amendments are simply for matters of form and for grammatical reasons.

The Examiner has rejected Claim 14 under 35 U.S.C. §112, second paragraph, as being indefinite. The Applicant respectfully traverses the Examiner's allegation that "said ink" does not have proper antecedent basis, since Claim 14 properly introduces "an ink" for printing the printed pattern, and then

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further defines "said ink" as including a microbial agent. Accordingly, the Examiner's rejection should be withdrawn.

The Examiner has rejected Claims 1, 2, 4-13, 18, 20, 33, 36, 38-41, 55, 56, 58, 59, and 61-64, under 35 U.S.C. §103 as being unpatentable over Dahlquist. The Examiner has rejected Claims 14-17, 19, 21, 37, 42-44, 60, and 68-70 under 35 U.S.C. §103 as being unpatentable over Dahlquist in view of Aamodt et al. The Examiner has rejected Claims 3, 35, and 57 under 35 U.S.C. §103 as being unpatentable over Dahlquist in view of Steitz. Claims 22-25, 45-47, 65-67, and 71 were rejected by the Examiner under 35 U.S.C. §103 as being unpatentable over Dahlquist in view of Petkovsek. The Examiner has rejected Claims 26-28, 48-50, and 72-74 under 35 U.S.C. §103 as being unpatentable over Dahlquist in view of Petkovsek and further in view of Didiano, Jr. Claims 29, 30, 32, 51, 54, 75, 76, and 78, were rejected under 35 U.S.C. §103 as being unpatentable over Dahlquist in view of Haan et al. Claims 31, 53, and 77 were rejected under 35 U.S.C. §103 as being unpatentable over Dahlquist in view of Haan et al. and further in view of Pace et al. For the following reasons, the prior art rejections are respectfully traversed.

The Applicant respectfully submits that Dahlquist does not teach or suggest an advertisement device for direct mail delivery to a recipient, including a synthetic panel, having a back side, a front side, at least one of the back side and the front side having indelible printing thereon (using indelible ink), and having a thickness sufficient to maintain integrity of the synthetic panel, as recited in amended Claims 1, 33, and 55.

The Examiner can take note that Claims 1, 33, and 55 have been amended to more clearly define the present invention with respect to the use of inks used in printing on the synthetic material, and to more clearly define that the printing is indelible (i.e., printed with the use of indelible inks). The definition of "indelible" is "making a mark not easily erased or washed away (i.e., written in *indelible* ink)", as defined in Webster's II New College Dictionary, copyright 1999. The inks and/or printing being indelible, or not being easily erased or washed away, is supported in the specification at page 6, line 22, *et seq.*, which states that "the use of a synthetic panel makes it necessary to utilize specialized printing materials and

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techniques... The printing inks are generally formulated for printing on the synthetic materials (as opposed to paper-type substrates) for enhanced adhesion and practical durability." As discussed and shown with exhibits in the personal interview, the surface of the synthetic panel is non-porous, and the inks used in printing on a synthetic panel are specially made for such usage, such that they do not wash away or easily degrade. In contrast, the prior art inks used in paper-type substrates is easily degraded and washed away.

With respect to the applied prior art, the Applicant notes that none of the applied prior art references teaches or suggests the use of synthetic panels in a printed advertising device. Rather, all the prior art references disclose paper as the material on which the advertising is printed.

In particular, Dahlquist, on whom the Examiner relies, discloses a conventional postcard printed advertising device, and is silent with respect to the type of material used, or to the use or advantage of any other shape other than a postcard shape. In fact, Dahlquist discloses that response envelopes, order forms, etc. can be included in the advertising device, which suggests that paper is used for all the postcard and response materials. Further, Dahlquist is silent with respect to the use of indelible inks, or any type of inks with respect to their device.

Although the Examiner alleges that it is obvious to use a synthetic panel in a desired arrangement, since Dahlquist is silent with respect to the type of material used and teaches only a postcard, and is silent with respect to the type of inks used for printing, the Examiner has not met her burden of establishing a *prima facie* case of obviousness. To establish such a *prima facie* case, there must be some suggestion or motivation, either in Dahlquist or generally available to one of ordinary skill in the art to modify the reference to achieve the claimed features of the present invention. Further, there must be a reasonable expectation of success. Still further, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion must be found in the prior art and not based on the Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974), and MPEP 2143.03.

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Since Dahlquist does not teach or suggest all of the claim limitations recited in amended Claims 1, 33, and 55, nor is there any suggestion or motivation in Dahlquist to achieve the claimed features of the present invention, Claims 1, 33, and 55 cannot be obvious over Dahlquist.

Thus, since the only suggestion on the record of the claimed advertising device including a synthetic panel which has indelible printing thereon, is that of the pending application, a rejection under §103 is improper. See *In re Laskowski*, 10 USPQ 2d 1397 (Fed. Cir. 1989).

Accordingly, Claims 1, 33, and 55 are not obvious over Dahlquist, and the rejection of Claims 1, 33, and 55 under 35 U.S.C. §103 should be withdrawn.

Further, since Claims 2, 4-13, 18, and 20 depend from Claim 1, and Claims 36, and 38-41 depend from Claim 33, and Claims 56, 58, 59, and 61-64 depend from Claim 55, they are also patentably distinguishable over Dahlquist for the reasons cited above with respect to Claims 1, 33, and 55.

With respect to Claims 14-17, 19, 21, 37, 42-44, 60, and 68-70, the Applicant respectfully submits that neither Dahlquist nor Aamodt et al. teaches or suggests a synthetic panel including a microbial agent manufactured therein or placed thereon, or an ink including a microbial agent disposed on the synthetic panel.

Rather, as stated above with respect to Claims 1, 33, and 55, Dahlquist do not teach or suggest the use of a synthetic panel or indelible inks/printing. Further, Aamodt et al. does not make up for the deficiencies in Dahlquist, since Aamodt et al. disclose only a porous paper, where a microbial agent can be impregnated in the pores of the paper. Aamodt et al. are silent with respect to including a microbial agent in ink or manufacturing a synthetic panel with an anti-microbial agent or disposing one on a synthetic panel as claimed. Since the manufacture of porous paper and non-porous synthetic materials would be vastly different, the present claims can not be obvious over Aamodt et al.

Thus, the Examiner has not met her burden of proving a *prima facie* case of obviousness, and the rejection of Claims 14-17, 19, 21, 37, 42-44, 60, and 68-70 over either the individual or the combination of the Dahlquist and Aamodt et al. references should be withdrawn.

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The addition of the Steitz, Petkovsek, Didiano Jr., Haan et al., and Pace et al. references do not make up for the deficiencies in Dahlquist and Aamodt et al.

Accordingly, Claims 1-3, 5-35, 37-40, 42-57, and 59-82 are patentable over the applied prior art and the Examiner's allowance of all the pending claims is hereby solicited.

With respect to new Claims 79 and 86, the Applicant respectfully submits that the applied prior art is silent with respect to an advertising device including a synthetic panel having a non-rectangular shape related to a theme of one of a product and a service. Rather, the prior art discloses regular rectangular-shaped postcard-type mailing devices. Thus, Claims 79 and 86 are patentable.

With respect to new Claims 81, 83, 87, the Applicant respectfully submits that the applied prior art is silent with respect to an advertising device including a synthetic panel having printing thereon; wherein the synthetic panel is made of a material having a memory such that a shape of the synthetic panel substantially maintains its integrity during handling. In the present invention, since the panel is a synthetic, it is able to retain its shape during handling without deforming (i.e., crushing, tearing etc.), as would result with the handling of paper postcard devices of the applied prior art. Thus, Claims 81, 83, and 87 are patentable.

With respect to new Claims 80, 84, and 88, the Applicant respectfully submits that the applied prior art is silent with respect to an advertising device including a synthetic panel having a non-porous surface adapted for receiving printing inks; wherein the printing inks are used to print on the non-porous surface of the synthetic panel such that the inks are indelible once applied. As stated above, the applied prior art is silent with respect to a synthetic panel, which by its nature is non-porous, and the use of indelible inks with such a synthetic panel. Rather, the applied prior art discloses only paper mailing devices which are porous in nature.

With respect to new Claims 82, 85, and 89, the Applicant respectfully submits that the applied prior art is silent with respect to an advertising device including a synthetic panel having a back side, a front side, at least one of said back side and said front side having printing thereon, the synthetic panel having a thickness sufficient to maintain integrity of the synthetic panel; wherein the printing on the

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synthetic panel is made using indelible inks such that no substantial material degradation of the printing occurs during handling. As stated above, the applied prior art disclose only paper advertising devices, which are subject to material degradation of the inks/printing during handling.

If the Examiner believes that there is any issue which could be resolved by a telephone or personal interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case, and any required fee for such an extension is to be charged to Deposit Account No. 19-3140.

Respectfully submitted,

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